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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|-----------------------|---------------------|------------------|
| 10/820,908 | 04/08/2004 | Kenneth Charles Feldt | EBC 1 | 8847 |
| 31704 | 7590 | 06/26/2006 | EXAMINER | |
| JOHN H. THOMAS, P.C. 536 GRANITE AVENUE RICHMOND, VA 23226 | | | STEVENS, ROBERT | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2176 | |

DATE MAILED: 06/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|------------------------------|--|
| Office Action Summary | Application No. 10/820,908 | Applicant(s) FELDT ET AL. | |
| | Examiner Robert Stevens | Art Unit 2176 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>8/27/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: application filed 4/8/2004.
2. This action is **NON-FINAL**.
3. The Office acknowledges information disclosure statement (IDS) filed on 8/27/2004.
4. Claims 1-11 are pending. Claim 1 is independent.

Drawings

5. The Office objects to the drawings.

Please refer to the accompanying Form PTO-948 Notice of Draftsperson's Patent Drawing Review.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate

changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

6. The disclosure is objected to because of the following informalities: The "Detailed Description Of The Invention" section essentially ends at page 52. The specification, however, continues with an "EmphaSign User Manual" section (running from pages 53-99). There is no lead in or reference to the User manual. The Office recommends labeling the User Manual as "Appendix A", and referring to that Appendix from the detailed description section.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. **Claims 1-11 are rejected under 35 U.S.C. 112, first paragraph**, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding independent claim 1, the as-filed specification did not contain any details as to how an “annotation and its connection ... is adapted to be displayed on a plurality of visual displays without regard to specific visual display technologies”.

Claims 2-11 are dependent on claim 1, and therefore are likewise rejected.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claims 1-6 and 8-11 are rejected under 35 U.S.C. 103(a)** as being unpatentable over Kross et al. (US Patent No. 6,285,369, filed May 28, 1998 and issued Sep. 4, 2001, hereafter referred to as "Kross") in view of Huynh et al (US Patent No. 6,161,114, filed Jun. 27, 2002 and issued Dec. 26, 2002, hereafter referred to as "Huynh").

Independent claim 1 states:

A method of annotating electronic messages with reference to electronically displayed documents comprising the steps of:
providing on a visual display an electronic document comprising a page of displayed content, wherein the displayed content comprises a plurality of subject items;
encoding a plurality of the subject items in a computer readable format;
displaying a list of encoded, subject items;
choosing an encoded, subject item;
connecting to the chosen item a text annotation;
displaying the text annotation and its connection to the chosen item;
whereby the annotation and its connection to the chosen item is adapted to be displayed on a plurality of visual displays without regard to specific visual display technologies.

Regarding these limitations ...

Kross discloses a visual display comprising a page of displayed content in Figure 4, showing an electronic notebook having a plurality of items (shown with the item in the forefront slightly obscuring at least one item). It was implied that these items were in computer readable format, as they are displayed within a computer application, as noted by column 4 lines 47-53 and as shown in Figure 4. Kross further displays a list of items in Figure 4 window #410, noting "part1", "extrusion1" and "extrusion2". Kross shows the result of choosing an item in window #405 of Figure 4, after the "extrusion1" item from window #410 was chosen. Arrow #451 provides a connection between the annotation note #449 and the item #457, as shown in Figure 4 and explained in column 7 lines 53-59. Kross discloses the displaying of an annotation and connection to an item in window #405 of Figure 4, showing elements #449 and #457 connected by #451.

However, Kross does not explicitly disclose that the annotation and its connection are adapted to a plurality of visual displays. Huynh, though, discloses implementing an annotation embodiment to be displayed in a variety of visual display applications, such as HTML authoring programs, and PowerPoint and other MS Office application programs, in paragraph [0062]. It is further noted that Huynh establishes a connection between an annotation and annotated subject matter by virtue of their proximity.

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Huynh for the benefit of Kross, because to do so would have allowed a user to semantically label objects, as taught by Huynh in

paragraph [0013]. These references were all applicable to the same field of endeavor, i.e., electronic document annotation.

Regarding dependent claims 2-4, Kross discloses a page of displayed subject items in Figure 4, showing an electronic notebook having a plurality of items (shown with the item in the forefront slightly obscuring at least one item). It was an obvious variant to one skilled in the art at the time of the invention to utilize other forms of data as subject items. See also Figure 5, noting #516 (graphics areas), #518 (text areas) and #520 (other areas).

Regarding dependent claim 5, Kross discloses a graphical connection between annotation and item in Figure 4, showing graphical line #451 connecting annotation #449 to item #457.

Regarding dependent claim 6, Kross discloses the well-known use of associating metadata with data in column 6 lines 53-58. It was an obvious variant to one skilled in the art at the time of the invention, as to what data one associated with metadata.

Regarding dependent claim 7, Kross discloses the use of audio/visual data in column 6 lines 58-60, describing an alternate embodiment employing other media such as audio and video.

Regarding dependent claims 8-9, Kross discloses a list of selectable items in window #410 of Figure 4. Window #405 shows the result of manually selecting the "extrusion1" item. Highlighting or selecting was well-known in the art at the time of the invention, as evidenced by col. 7 lines 11-18, discussing selection (or highlighting) of notes, it being an obvious variant to one skilled in the art at the time of the invention as to what object was selected/highlighted.

Regarding dependent claim 10, Kross discloses associating a plurality of items with a plurality of annotations in column 9 lines 16-24, discussing making multiple connections to multiple notes. Figure 5 of Kross further illustrates this concept.

Regarding dependent claim 11, Kross discloses remoting of objects in col. 6 lines 44-48, it being noted that the particular object being accessed/displayed remotely was an obvious variant to one skilled in the art at the time of the invention.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Non-Patent Literature

Zellweger, Polle T., et al., "Fluid Annotations in an Open World", HT '01, Aarhus, Denmark, Aug. 2001, pp. 9-18.

Zellweger, Polle T., et al., "Fluid Links for Informed and Incremental Link Transitions", HyperText '98, Pittsburgh, PA, © 1998, pp. 50-57.

Chang, Bay-Wei, et al., "A Negotiation Architecture for Fluid Documents", UIST '98, San Francisco, CA, © 1998, pp. 123-132.

DeRose, Steven J., et al., "XML Linking", ACM Computing Surveys, Vol. 31 No. 4es, Dec. 1999, pp. 1-12.

US Patent Application Publications

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| Hull et al | 2005/0216851 |
| Milo et al | 2004/0148278 |
| Engel | 2004/0163041 |
| Duncan et al | 2003/0013073 |
| Block et al | 2003/0037038 |

US Patents

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| Beezer et al | 7,028,267 |
| Lieberman et al | 7,028,253 |
| Mäkipää et al | 6,556,217 |
| Gupta et al | 6,956,593 |
| Chiu et al | 6,452,615 |
| Sundaresan et al | 6,651,059 |
| Gupta et al | 6,546,405 |
| Kahn et al | 6,332,150 |
| Covington et al | 5,524,193 |
| Lopresti et al | 5,832,474 |
| Light et al | 5,831,631 |
| King et al | 5,600,775 |
| Hou et al | 5,838,313 |
| Jennings | 5,781,186 |

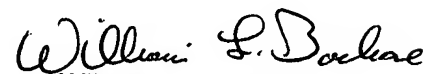
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Stevens whose telephone number is (571) 272-4102. The examiner can normally be reached on M-F 6:00 - 2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R. Herndon can be reached on (571) 272-4136. The current fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Additionally, the main number for Technology Center 2100 is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robert Stevens
Art Unit 2176
Date: April 28, 2006

rs


WILLIAM BASHORE
PRIMARY EXAMINER